



UNITED STATES DEPARTMENT OF COMMERCE  
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08/731,499

DN

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/731,499	10/16/96	GRAY	J 023070-06891

EXAMINER

HM12/0219

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ART UNIT

PAPER NUMBER

1642

21

DATE MAILED: 02/19/99

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

#### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on December 11, 1998

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 days month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-23 + 45 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) 1-23 + 45 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

1. The Amendment filed December 11, 1998 (Paper No. 20) in response to the Office Action of June 9, 1998 (Paper No. 17) is acknowledged and has been entered. Previously pending claims 1, 18 and 19 have been amended and new claim 45 has been added. Claims 1-23 and 45 are currently being examined.

3. Upon review and reconsideration it has become clear that the nucleic acid molecules claimed in claims 1-23 have no disclosed structural or functional relationship and therefore are separate inventions and not obvious one over the other. Therefore, restriction to one of the following inventions is required under 35 U.S.C. § 121:

**Group 1.** Claims 1-3, 22, 23, 45 are drawn to an isolated nucleic acid molecule comprising a polynucleotide sequence that specifically hybridizes to SEQ NO:2 or a complement thereof classified in Class 536, subclass 23.1.

**Group 2.** Claims 1, 4, 5, 22, 23, 45 are drawn to an isolated nucleic acid molecule comprising a polynucleotide sequence that specifically hybridizes to SEQ NO:3 or a complement thereof classified in Class 536, subclass 23.1.

**Group 3.** Claims 1, 6, 7, 22, 23, 45 are drawn to an isolated nucleic acid molecule comprising a polynucleotide sequence that specifically hybridizes to SEQ NO:4 or a complement thereof classified in Class 536, subclass 23.1.

**Group 4.** Claims 1, 8, 9, 22, 23, 45 are drawn to an isolated nucleic acid molecule comprising a polynucleotide sequence that specifically hybridizes to SEQ NO:5 or a complement thereof classified in Class 536, subclass 23.1.

**Group 5.** Claims 1, 10, 11, 22, 23, 45 are drawn to an isolated nucleic acid molecule comprising a polynucleotide sequence that specifically

hybridizes to SEQ NO:6 or a complement thereof classified in Class 536, subclass 23.1.

**Group 6.** Claims 1, 12, 13, 22, 23, 45 are drawn to an isolated nucleic acid molecule comprising a polynucleotide sequence that specifically hybridizes to SEQ NO:7 or a complement thereof classified in Class 536, subclass 23.1.

**Group 7.** Claims 1, 14, 15, 22, 23, 45 are drawn to an isolated nucleic acid molecule comprising a polynucleotide sequence that specifically hybridizes to SEQ NO:8 or a complement thereof classified in Class 536, subclass 23.1.

**Group 8.** Claims 1, 16, 17, 22, 23, 45 are drawn to an isolated nucleic acid molecule comprising a polynucleotide sequence that specifically hybridizes to SEQ NO:9 or a complement thereof classified in Class 536, subclass 23.1.

**Group 9.** Claims 1, 18, 19, 22, 23, 45 are drawn to an isolated nucleic acid molecule comprising a polynucleotide sequence that specifically hybridizes to SEQ NO:10 or a complement thereof classified in Class 536, subclass 23.1.

**Group 10.** Claims 1, 20, 21, 22, 23, 45 are drawn to an isolated nucleic acid molecule comprising a polynucleotide sequence that specifically hybridizes to SEQ NO:12 or a complement thereof classified in Class 536, subclass 23.1.

Art Unit: 1642

4. The inventions are distinct, each from the other because of the following reasons:

Inventions 1-10 as disclosed are biologically and chemically distinct, unrelated in structure and function, made by and used in different methods and are therefore distinct inventions.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R.

§ 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

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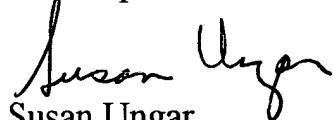
8. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (703) 305-2181. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310. The fax phone number for this Art Unit is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Effective, February 7, 1998, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1642.

  
Susan Ungar

February 16, 1999